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OFFICE OF PETITIONS

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ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

In re Application of :
Rao, et al. :
Application No. 10/780,399 : ON REQUEST FOR
Filed: February 17, 2004 : RECONSIDERATION OF
Attorney Docket Number: VDX5060USPCT2 : PATENT TERM ADJUSTMENT

This is a decision on the petition under 37 CFR 1.705(b), filed July 6, 2010. Applicants believe that they should be accorded an additional PTA of 851 days. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue this patent.

Insofar as the instant application for patent term adjustment requests reconsideration of the patent term adjustment solely as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file a request for reconsideration of patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a

request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

However, a review of the file reveals that Applicants should have been assessed additional delay due to the abandonment of the application pursuant to 37 CFR 1.704(c)(3). The application became abandoned for failure to timely reply to a June 15, 2007 Office action on September 16, 2007. Applicants filed a petition to revive on December 2, 2008, which was granted in a decision mailed on December 11, 2008. Accordingly, pursuant to 37 CFR 1.704(c)(3), 453 days of Applicant delay should have been assessed.


In addition, a review of the file also reveals that Applicants should have been assessed delay pursuant to 37 CFR 1.704(c)(10). The Office mailed a Notice of Allowance on May 4, 2010. In reply, Applicants filed an RCE on August 3, 2010. The Office mailed a subsequent Notice of Allowance on August 18, 2010. Accordingly, pursuant to 37 CFR 1.704(c)(10), 16 days of Applicant delay should have been assessed.

In view thereof, the correct determination of PTA prior to issuance is **zero (0) days** (537 days of PTO delay, reduced by 611 (74+453+63+2+16) days of Applicant delay).

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged.

The application is being forwarded to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Petitions Attorney Cliff Congo at (571) 272-3207.


Anthony Knight
Director
Office of Petitions

Enc: copy of PAIR screen

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.



Patent Term Adjustments



PTA/PTE Information Patent Term Adjustment Patent Term Extension

Application Number*: 10780399 Search Explanation of PTA Calculation Explanation of PTE Calculation

PTA Calculations for Application: 10780399

Application Filing Date 02/17/2004	Overlapping Days Between (A and B) or (A and C) 0
Issue Date of Patent	Non-Overlapping USPTO Delays: 537
A Delays: 537	PTO Manual Adjustment: 472
B Delays: 0	Applicant Delay (APPL): 139
C Delays: 0	Total PTA (days) 0

* - Sorted Column

File Contents History

Action Number	Action Recorded Date	Action Due Date	Action Code	Action Description	Duration PTO	Duration APPL	Parent Action Number
90	09/25/2010		P028	Adjustment of PTA Calculation by PTO		572	0
84	08/18/2010		MN/=	Mail Notice of Allowance			0
83	08/13/2010		IREV	Issue Revision Completed			0
82	08/13/2010		DVER	Document Verification			0
81	08/13/2010		N/=	Notice of Allowance Data Verification Completed			0
80	08/13/2010		EXA	Examiner's Amendment Communication			0
79	08/13/2010		CNTA	Notice of Allowability			0
73	08/06/2010		ABN9	Disposal for a RCE / CPA / R129			0
74	08/03/2010		RCEX	Request for Continued Examination (RCE)			0
72	08/03/2010		RCAP	Reference capture on IDS			0
71	08/03/2010		M844	Information Disclosure Statement (IDS) Filed			0
70	08/03/2010		BRCE	Workflow - Request for RCE - Begin			0
69	07/06/2010		FLDC	Finished Initial Data Capture			0
68	07/06/2010		PET2	Petition Entered			0
67	05/05/2010		EIDC	Export to Initial Data Capture			0
66	05/04/2010		ELC_RVW	Electronic Review			0
65	05/04/2010		EML_MTR	Email Notification			0
64	05/04/2010		EML_MTF	Email Notification			0
63	05/04/2010		MEXA	Mail Examiner's Amendment			0
62	05/04/2010		MN/=	Mail Notice of Allowance			0
61	04/30/2010		IREV	Issue Revision Completed			0
60	04/30/2010		DVER	Document Verification			0
59	04/30/2010		N/=	Notice of Allowance Data Verification Completed			0
58	04/30/2010		DOCK	Case Docketed to Examiner in GAU			0
57	04/12/2010		EXA	Examiner's Amendment Communication			0
56	04/12/2010		CNTA	Notice of Allowability			0
55	04/07/2010		EXIN	Examiner Interview Summary Record (PTOL - 413)			0
51	02/06/2010		FWDX	Date Forwarded to Examiner			0
50	01/10/2010		A...	Response after Non-Final Action			0
49	10/13/2009		MCTNF	Mail Non-Final Rejection			0
48	10/13/2009		CTNF	Non-Final Rejection			0
47	08/07/2009		FWDX	Date Forwarded to Examiner			0
45	08/07/2009		FWDX	Date Forwarded to Examiner			0
43	08/07/2009		ABN9	Disposal for a RCE / CPA / R129			0
46	08/03/2009		AMSB	Amendment Submitted/Entered with Filing of CPA/RCE			0
44	08/03/2009	08/01/2009	RCEX	Request for Continued Examination (RCE)		2	41
42	08/03/2009		BRCE	Workflow - Request for RCE - Begin			0
41	05/01/2009		MCTFR	Mail Final Rejection (PTOL - 326)			0
40	04/30/2009		CTFR	Final Rejection			0
39	02/27/2009		FWDX	Date Forwarded to Examiner			0
37	02/12/2009		PA...	Change in Power of Attorney (May Include Associate POA)			0
36	02/09/2009		CAD	Correspondence Address Change			0
38	02/03/2009	12/02/2008	A...	Response after Non-Final Action		62	33
35	01/08/2009		MINA	Mail Notice of Informal or Non-Responsive Amendment			0
32	01/08/2009		MHRA8	Mail Notice of Rescinded Abandonment			0
34	01/07/2009		FWDX	Date Forwarded to Examiner			0
31	01/07/2009		NRAB	Notice of Rescinded Abandonment in TCS			0
30	12/11/2008		MPREV	Mail-Petition to Revive Application - Granted			0
29	12/11/2008		PREV	Petition to Revive Application - Granted			0
33.1	12/02/2008		A.I.	Informal or Non-Responsive Amendment after Examiner Action			0
33	12/02/2008		A...	Response after Non-Final Action			0
28	12/02/2008		PET	Petition Entered			0
27	12/26/2007		MABN2	Mail Abandonment for Failure to Respond to Office Action			0
26	12/20/2007		ABN2	Aband. for Failure to Respond to O. A.			0
25	06/15/2007		MCTNF	Mail Non-Final Rejection			0
24	06/11/2007		CTNF	Non-Final Rejection			0
23	04/03/2007		FWDX	Date Forwarded to Examiner			0
22	03/21/2007	01/06/2007	ELC	Response to Election / Restriction Filed		24	20
21	03/21/2007		XT/G	Request for Extension of Time - Granted			0
20	10/06/2006	04/17/2005	MCTRS	Mail Restriction Requirement	537		-1
19	10/02/2006		CTRS	Requirement for Restriction / Election			0
18	06/15/2004		TSSCOMP	IFW TSS Processing by Tech Center Complete			0
17	06/15/2004		DOCK	Case Docketed to Examiner in GAU			0
16	06/04/2004		TI1050	Transfer Inquiry to GAU			0
12	05/11/2004		COMP	Application Is Now Complete			0
15	05/10/2004		WROIPE	Application Return from OIPE			0
14	05/10/2004		ROIPE	Application Return TO OIPE			0
13	05/10/2004		WROIPE	Application Return from OIPE			0
11	05/10/2004		ROIPE	Application Return TO OIPE			0
9	05/10/2004		COMP	Application Is Now Complete			0
6	05/10/2004		COMP	Application Is Now Complete			0
10	05/08/2004		WROIPE	Application Return from OIPE			0
8	05/08/2004		ROIPE	Application Return TO OIPE			0
7	05/08/2004		OIPE	Application Dispatched from OIPE			0
5	03/31/2004		L128	Cleared by L&B (LARS)			0
4	03/23/2004		L198	Referred to Level 2 (LARS) by OIPE CSR			0
3	03/23/2004		CLSS	CASE CLASSIFIED BY OIPE			0
2	03/05/2004		SCAN	IFW Scan & PACR Auto Security Review			0
1	02/17/2004		IEOX	Initial Exam Team no			0

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